

**REMARKS**

This amendment is in response to an Interview (Paper No. 14) on February 10, 2004, a non-final Office action (Paper No. 12) mailed 29 October 2003. Claims 1, 2, 4-8 and 16-32 are pending in this application. No claims are being amended by this amendment. The Examiner has withdrawn claims 1, 2, 4-8, 21-24 and 30-32 from consideration on Paper No. 12.

In Paper No. 12, the Examiner has rejected claims 16-20 and 25-29 under 35 U.S.C. 103 (a) as being unpatentable over U.S. Patent No. 6,317,836 to Goren *et al* in view of U.S. Patent No. 6,012,103 to Sartore *et al* and further in view of alleged applicant's admitted prior art.

**Summary of Goren '836, Sartore '103 and Applicant's invention**

Goren '836 is a hardware key used to gain access to a computer. The hardware key in Goren '836 attaches to a printer port on the computer. The hardware key has a large number of connector pins, 13 of 25 that are used in the password verification. There is no mention of USB in Goren '836

Sartore '103 pertains to a peripheral for a computer that can connect to the USB port of a computer. The computer reads the peripheral device identification code so that the host computer can download the appropriate configuration information to the peripheral. Sartore '103 does not pertain to a hardware key, a computer security device or passwords of any kind.

Applicant's invention pertains to a memory stick device that plugs in to a computer's USB

port. The device can be used as a key necessary to boot the computer up. To do so, a password is read from the USB device and is compared with a password in the host computer prior to booting up. If the passwords do not match, or if there is no USB key attached to the host's USB port, the host displays an error message in addition to not booting up.

In Paper No. 12, the Examiner combines Sartore '103 with Goren '836 to reject Applicant's claims. In other words, the Examiner, in Paper No. 12, uses Sartore '103 to fill in for the deficiencies of Goren '836 to reject Applicant's claims. Applicant disagrees.

**1. It was inappropriate for the Examiner to use Sartore '103 to fill in for the deficiencies of Goren '836**

**A. Goren '836 teaches away from Applicant's claimed invention**

Goren '836 teaches use of a printer port having 25 pins for a security key. Goren '836 is replete (see columns 5 and 6 of Goren '836) of teachings that the more pins the better because the more pins on a port for a hardware key, the more combinations of passwords are possible. For example, having 13 pins dedicated to the password key,  $2^{13}$  combinations, or 8192 possible passwords are possible. Meanwhile, Applicant's invention seeks the simplicity and wide availability of using a USB connector. A USB connector has four pins which is very few and Goren '836 teaches away from. MPEP 2141.02 mandates that the prior art reference must be considered in its entirety, including disclosures that teach away from the claims. Applicant submits that the Examiner never considered these teachings of Goren '836 in Paper No. 12 that teach away from Applicant's

claimed invention.

**B. Applicant submits that Sartore ‘103 renders the primary reference to Goren ‘836 unsatisfactory for its Intended Purpose**

MPEP sections 2143.01 and 2145 mandate that the proposed combination cannot render the prior art unsatisfactory for its intended purpose. In Paper No. 12, the Examiner used Goren ‘836 in view of Sartore ‘103 to reject Applicant’s claims. As discussed previously, Goren teaches that it is better and it is necessary to have as many pins as possible connected to a security device so that there can be a greater number of possible combinations of passwords. For example, Goren ‘836 teaches that 13 pins results in 8192 combinations and 17 pins results in 131072 combinations. Sartore ‘103 teaches use of USB peripheral device such as a printer. A USB device has 4 pins. If the number of pins in Goren ‘836 were reduced to 4, the primary purpose of Goren ‘836 (to increase the number of pins used resulting in a larger number of possible passwords) would be destroyed. Since Sartore ‘103 destroys the primary purpose of Goren ‘836, Applicant submits that the combination of Goren ‘836 in view of Sartore ‘103 lacks motivation under MPEP 2143.01. Since the combination of prior art in Paper No. 12 lacks the requisite motivation to combine, the 35 U.S.C. 103 rejection of Paper No. 12 must be withdrawn.

**C. One having ordinary skill in the art would not turn to Sartore ‘103 to fill in for the deficiencies of Goren ‘836**

Applicant submits that one having ordinary skill in the art would not be motivated to turn to

Sartore '103 to fill in for the deficiencies of Goren '836. This is because Goren '836 discusses in great length that the hardware key has 25 pins, at least 13 are not grounded. Goren '836 uses this large number of pins in the hardware key to obtain a large amount of possible password combinations so that it is not likely for an unauthorized user to luckily choose the appropriate password by chance. Goren '836 discusses at great length that the large number of pins in the hardware key are also necessary in the password comparison process. Since a USB port has only four pins, and since Goren '836 is relies on and prefers having a large number of pins in the key and in the port, Applicant submits that one having ordinary skill in the art would not be motivated to turn to the four pin USB of Sartore '103 to fill in for the deficiencies of Goren '836. Such a reduction of number of pins in a USB connection would be unattractive and unforeseen to Goren '836. Therefore, there is no proper motivation as mandated by MPEP 2143.01 for a proper 35 U.S.C. 103 (a) rejection in paper No. 12.

Applicant submits furthermore that one having ordinary skill in the art would not be motivated to turn to Sartore '103 to fill in for the deficiencies of Goren '836 because Sartore '103 does not pertain to hardware keys, password verification, computer security and the like. However, Goren '836 does pertain to security and a hardware key. Therefore, Applicant submits that one having ordinary skill in the art would not turn to a reference that pertains to peripheral devices that are not security related (Sartore '103) to fill in for the deficiencies of a reference that pertains only to security, passwords and a hardware key (Goren '836). In other words, Applicant is again showing that MPEP 2143.01 has not been properly satisfied in Paper No. 12.

**2. Even if combined, the proposed combination of Paper No. 12 does not result in Applicant's claimed invention**

**A. Applicant's awareness that USB is emerging technology is part of the inventive process and is not an admission**

In Paper No. 12, the Examiner states that both Sartore '103 and Applicant's APA for a teaching that USB is an emerging technology and thus the hardware key of Goren '836 can be made in the form of a USB plug in. Applicant disagrees. Applicant's statement that USB is an emerging technology in Applicant's patent application is evidence that Applicant has identified a problem in the prior art and that Applicant has identified a need for Applicant's inventive concept. Applicant is not admitting that a USB hardware key is prior art. *Applicant submits that identifying a need in the marketplace or a need in technology is part of the inventive process, not an admission that Applicant's claimed invention is defeated by an admission of the Applicant.*

**B. None of the applied prior art teaches a USB security device**

Regarding the Examiner's assertion that Sartore '103 states that USB is an emerging technology and thus the hardware key of Goren '836 can be embodied in a USB device is obvious is flawed. Sartore '103 pertains to a non-security peripheral device, not a hardware key. Therefore, Applicant submits that one reading the statement in Sartore '103 that USB is an emerging technology would obviously infer that the hardware key of Goren '836 can be made as a USB device is flawed. There is no teaching in the prior art that a hardware key is in the form of a USB device. Therefore, the claim rejections of Paper No. 12 must be withdrawn.

The fact of the matter still remains that Applicant is claiming a USB device that is used as a hardware key. The Examiner, in Paper No. 12, has failed to identify any prior art where a USB device is a hardware key. Instead, in Paper No. 12, the Examiner is using Applicant's claims as a blueprint from which to pick and choose features from different patents to reject Applicant's claims. The fact of the matter still remains that there is no teaching of a USB security key in any reference in Paper No. 12.

**C. Even if Sartore '103 were combinable with Goren '836, Applicant's claimed invention would not result**

Applicant further submits that even if Sartore '103 could be combined with Goren '836, Applicant's claimed invention would not result. Applicant submits that if Goren '836 were to be modified according to Sartore '103 as proposed by the Examiner in Paper No. 12, a USB hardware key would not result. This is because Sartore '103 does not pertain to a hardware key but to a USB peripheral that the host can recognize by a host computer when plugged in. Therefore, if Sartore '103 were combinable with Goren '836, Applicant's claimed invention would not result. Instead, what would result is a non security and easy to recognize peripheral would result.

**3. None of the applied prior art teaches or suggests the claimed feature of displaying an error message**

In Applicant's rejected claims 19, 20 and 25-29, Applicant claims display of an error message if the passwords do not match and when the USB device is not present in the USB port during

booting. In Paper No. 12, the Examiner rejected these claims solely by referring to box S58 in FIG. 7 of Goren '836. Box S58 states "Run invalid access routing" However, there is no teaching in Goren '836 or any of the prior art of 1) an error message, 2) a display that displays an error message, 3) the condition for displaying an error message is if the password in the USB security device does not match the password stored inside the computer and/or 4) the condition for display is whether or not a USB key is attached to the computer's port. Applicant has claimed these four features but none of these four features is either taught or suggested by either Goren '836 and/or Sartore '103. Because the Examiner has failed the all elements rule for a 35 U.S.C. 103 rejection, the rejection of Applicant's claims in Paper No. 12 must be withdrawn.

#### **4. Interview on February 10, 2004**

At the interview on February 10, 2004 (Paper No. 14), the Examiner refused to issue a new, non-final Office action in view of the above. Instead, the Examiner instructed Applicant to file a response to Paper No. 12 and then the Examiner will reconsider Applicant's arguments. In particular, at the interview, it was discussed 1) Goren '836 teaches a preference for a large number of pins on the security key port which is a teaching away from Applicant's claimed invention and 2) neither Goren '836 nor Sartore '103 nor S58 of FIG. 7 of Goren '836 teaches the display of the error message, especially when the passwords do not match. The Examiner has agreed to reconsider these issues upon filing of this response.

A fee of \$110.00 is incurred by filing of a petition for a one month extension of time, set to expire on 29 February 2004. Applicant's check drawn to the order of Commissioner accompanies this Amendment. Should the check become lost, be deficient in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

In view of the above, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Reconsideration of the rejections and objections is requested. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,

  
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